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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,262	12/15/2003	Junko Sato	00862.023372.	1505
5514 7590 07/26/2007 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			EXAMINER PANNALA, SATHYANARAYAN R	
			ART UNIT 2164	PAPER NUMBER
			MAIL DATE 07/26/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.		Applicant(s)	
	10/734,262		SATO ET AL.	
	Examiner		Art Unit	
	Sathyanarayan Pannala		2164	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's Amendment filed on 5/9/2007 has been entered with amended claims 1,4-6, 8 and 10. In this Office Action, claims 1, 3-10 are pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1, 3-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakatsuyama ET AL. (us Patent 5,765,177) hereinafter Nakatsuyama, and in view of Nolan (US Patent 5,933,599) hereinafter Nolan.

4. As per independent claims 1, 5-6, Nakatsuyama teaches the document processing method to perform the processes of retrieve, insertion, composition, and update documents or document parts (col. 3, lines 15-20). Nakatsuyama teaches the claimed, displaying a document structure of a first document file in a display region in a tree structured form (Fig. 2, col. 7, lines 14-16). Nakatsuyama teaches the claimed, inputting an instruction to insert at least one second document file to the first document file displayed in the display region (Fig. 2, col. 7, lines 32-36). Nakatsuyama teaches the claimed, displaying in response to the input instruction, a menu dialog including a plurality of selection units corresponding to a plurality of insertion methods, respectively, wherein the plurality of insertion methods include at least a first method in which one chapter is newly generated at the insertion position and pages of the second document file are arranged in the newly generated chapter, and a second insertion method in which pages of the second document file are arranged into an existing chapter at the insertion position (Fig. 2, col. 7, lines 32-36). Nakatsuyama teaches the claimed, inserting the second document file into the first document file on the basis of the insertion method determined in said determining step (Fig. 2, col. 10, lines 31-37). Claim 6 other limitations, Nakatsuyama teaches the claimed, memory unit, input device, display device and processor (Fig. 2, col. 7, lines 8-10).

Nakatsuyama does not explicitly teach determining selection from menu dialog. However, Nolan teaches the claimed, determining an insertion method from the plurality of insert methods, based on selection of a selection unit from the plurality of selection

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units in the menu dialog (Fig. 4-9, col. 9, lines 30-48; col. 10, lines 30-43 and col. 11, lines 11-58). Thus, it would have been obvious to one of ordinary skill in the data processing art at the time of the invention, to have combined the teachings of the cited references because Nolan's teachings would have allowed Nakasuyama's method provides a conventional network shell with user interface for the entire network (col. 1, lines 64-65).

5. As per dependent claim 3, Nakatsuyama teaches the claimed, a document structure type candidate corresponding to at least one of the insertion position and the number of second document files is presented (Fig. 12, col. 19, lines 35-53).

6. As per dependent claim 4, Nakatsuyama teaches the claimed, the document structure includes at least a chapter in an upper layer and a page in a lower layer, the plurality of insertion methods further includes a third insertion method in which chapters are newly generated from the insertion position by the number of second document files and pages of corresponding files are arranged in the generated chapters (Fig. 18-19, col. 25, lines 38-44).

7. As per dependent claims 7-10, Nakatsuyama does not teach user drag and drop and menu dialog in windows explorer concept. However, Nolan teaches the claimed, the document structure type candidate corresponding to at least one of the insertion position and the number of second document files is presented (Fig. 24, col. 26,

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lines 45-52). Thus, it would have been obvious to one of ordinary skill in the data processing art at the time of the invention, to have combined the teachings of the cited references because Nolan's teachings would have allowed Nakasuyama's method provides a conventional network shell with user interface for the entire network (col. 1, lines 64-65).

Response to Arguments

8. Applicant's arguments filed on 5/9/2007 with respect to claims 1, 3-10 have been fully considered but they are moot in view the new grounds of rejection.

a) Applicant's argument stated as "An input instruction, a menu dialog... (see page 10, paragraph last).

In response to Applicant's argument, Examiner respectfully disagrees because the reference by Nolan does teach the menu dialog. The two references combined do teach all claims and their limitations.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sathyanarayan Pannala whose telephone number is (571) 272-4115. The examiner can normally be reached on 8:00 am - 5:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Rones can be reached on (571) 272-4085. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Sathyanarayan Pannala
Primary Examiner

srp
July 21, 2007